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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,813	12/05/2003	Biplav Srivastava	JP920030179US1	1921
<div>7590 Frederick W. Gibb, III McGinn & Gibb, PLLC Suite 304 2568-A Riva Road Annapolis, MD 21401</div>				
08/25/2009				
EXAMINER				
PANNALA, SATHYANARAYA R				
ART UNIT		PAPER NUMBER		
2164				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,813

Applicant(s)

SRIVASTAVA, BIPLAV

Examiner

Sathyannarayan Pannala

Art Unit

2164

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 17, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's Amendment filed on 6/30/2009 has been entered with amended claims 16 and 30. In this Office Action, claims 16-17 and 30-31 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 16 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The one statement in the first limitation claimed as "wherein codes are represented in a form corresponding to a type of analysis performed on said codes" is indefinite, not clear and ambiguous.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-17 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zambo et al. (US Patent 6,985,907) hereinafter Zambo, in view of McCollum et al. (USPA Pub. 2005/0091640 A1) hereinafter McCollum, in view of Bigus et al. (US Patent 7,136,843) hereinafter Bigus, and further in view of Applicant Admitted Prior Art (AAPA).

6. As per independent claims 16 and 30, Zambo teaches a method of codifying field claims with the most severe of the applicable condition codes (col. 2, lines 17-19). Zambo teaches the claimed, an automated computer implemented method for identifying applicable provisions in codes (Fig. 2, col. 2, lines 19-21 and col. 4, lines 45-47, the codes are applied based on severity ranking of plurality of condition of codes which is the same concept as the current invention the codes are identified based on provision codes). Zambo teaches the claimed, selecting a rules system by a computer, rules system includes a plurality of codes are represented in a form corresponding to a particular type of analysis performed on said codes (Table 2, col. 6, lines 65-67).

Zambo teaches the claimed, mapping said codes automatically create target rules representing said codes based on said selected rules system by said computer, by transforming a logical structure of said codes to target rules using grammar and syntax

of said natural language text of said selected rules system (Fig. 2, col. 4, lines 45-61 and table 2, col. 6, lines 65-67).

Zambo does not explicitly teach rules. However, McCollum teaches the claimed, identifying applicable provisions of said target rules based on said first and second evaluations by said computer (page 1, paragraph [0003]). McCollum also teaches the claimed, populating a template of generated target rules with data from said codes based on said selected rules system (Fig. 6, page 23, paragraph [0277]).

Zambo does not explicitly teach applying evaluation function to said target rules. However, McCollum also teaches the claimed, applying evaluation functions to said target rules that represent said codes, to refine said target rules, wherein a first evaluation function comprises one user's perspective of said codes, and wherein a second evaluation function comprises a trigger event relating to said codes (Fig. 3, page 14, paragraph [0236]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because McCollum's teachings would have allowed Zambo's method to execute plurality of rules simultaneously instead of executing sequentially in order to use computer resources more efficiently (page 1, paragraph [0003]).

Zambo and McCollum do not explicitly teach rule system including one of fuzzy rules and other listed rules. However, Bigus teaches the claimed, rule system including one of fuzzy rules, if-then-else-rules, and declarative rules (col. 4, line 64 to col. 5, line 2; col. 4, lines 30-33 and col. 5, lines 15-26). Bigus also teaches outputting said applicable provisions of said target rules by said computer (Fig. 6, col. 8, lines 5-6).

Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Bigus' teachings would have allowed Zambo's method for initialization or setup code is required to intermix with the processing and evaluation of declarative rules-based knowledge (col. 1, lines 64-67).

Zambo, McCollum and Bigus do not explicitly teach types of codes. AAPA teaches the claimed, codes comprise natural language text of one of laws, policy statements, contract provisions, agreements, regulations, rules of association, constitutions, and codes of conduct (page 1, paragraph [0002]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because AAPA's teachings would have allowed Zambo's method to improve using codes (page 1, paragraph [0005]).

7. As per dependent claims 17 and 31, Zambo teaches the claimed, applicable codes comprise a classification codes used for classifying said provisions provided in said document (Fig. 1, Table 1, col. 4, lines 12-20).

Response to Arguments

8. Applicant arguments with respect to claims 16-17 and 30-31 have been considered but they are not persuasive and details as follows:

a) Applicant argument regarding 35 U.S.C. 112, 2nd paragraph rejection stated as "Applicant respectfully requests that the examiner withdraws this 35 U.S.C. 112 rejection."

In response to Applicants argument, Examiner respectfully agrees. However, Applicant amended claims 16 and 30 have introduced a new kind of error because of using the phrase "wherein codes are represented in a form corresponding to a type of analysis performed on said codes" Therefore, 35 U.S.C. 112, 2nd paragraph rejection is maintained with a different kind as indefinite.

b) Applicant argument regarding rejection of claims under 35 U.S.C. 103 stated as "Applicant submits, that neither Zambo, nor McCollum, Bigus and AAPA, nor any alleged combination thereof, teaches or suggests..." (See page 7, par. one).

In response to Applicants argument, Examiner respectfully disagrees, because when it is a part of Applicant's disclosure, then it would have supported with detailed explanation rather than listing. However, Applicant utterly failed to claim from the detailed description and to overcome the prior art, Applicant claimed the limitation by extracting from the background of the invention and which is considered and admitted by Applicant as well known in the art. The limitation of "codes comprising...one of laws..." is not disclosed anywhere in the Detailed Description.

c) Applicant argument regarding rejection of claims under 35 U.S.C. 103 stated as "nowhere in the cited prior art is there any disclosure of transforming a logical structure of codes comprising natural language...using grammar and syntax of the natural language text."

In response to Applicants argument, Examiner respectfully disagrees. The reasons are: 1) Applicant is silent about the differences between the rules system and target rules system. 2) Zambo clearly explained what the codes are and how they are represented, for example, the first character preferably indicates the vehicle component or concern, i.e., "T" for tires (Fig. 2, col. 4, lines 45-61). Whereas Applicant codes were not disclosed how they are mapped either in the specification or in drawings.

d) Applicant argument regarding rejection of claims under 35 U.S.C. 103 stated as "No person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight."

In response to Applicants argument, Examiner respectfully disagrees. Zambo description well explained and perfectly fits to the claimed invention. In fact, Applicant claims are not relevant. For example, claimed limitation is: codes (such as civil and criminal justice...) are mapped to target rules and these rules includes fuzzy rules, if-then-else-rules and declarative rules (emphasis added).

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sathyanarayan Pannala/
Primary Examiner, Art Unit 2164

srp
August 24, 2009